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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

EXAMINER

SUHOL, DMITRY

ART UNIT PAPER NUMBER

3712

DATE MAILED: 04/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,545

Applicant(s)

HORNSBY ET AL.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 9 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-13, 33 and 43 of copending Application No. 09/931570 in view of Tachau et al (U.S. Patent No. 6,346,025). Copending application no. 09/931570 discloses all of the elements of the claims but for armor detachably carried by the body and protecting at least a portion of the body and the device being transformable. However Tachau discloses an amusement device, which teaches armor detachably carried by the body and protecting at least a portion of the body (fig. 8) and a device that is transformable (col. 19, lines 32-37).

This is a provisional obviousness-type double patenting rejection.

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Claims 1-2 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 10 of copending Application No. 09/966680. Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters which are obvious over each other and only differ in breadth of terminology used. For example, "means for keying" of the application is an obvious variation in meaning of the limitation "means for holding information" in the copending application 09/966680 because they are disclosed as the same feature.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 11, the phrase "the microprocessor being configured to control positioning of the armor" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. There is no support in the specification of a microprocessor control positioning of armor.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Barton et al '135. Barton discloses an amusement device containing all the elements of the claims including, a body (figure 5, element 12), features carried by the body (figure 5, wheels), means for powering the device and at least some of the features carried by the body (col. 4, lines 23-30), means for mechanical/electro mechanical (as required by claim 18) keying being discrete from the device (figure 5, element 150), a means for receiving the means for mechanical keying carried by the body (figure 5, element 154) and a microprocessor operably coupled to the means for powering and means for receiving (figure 4, element 122 and col. 10, lines 2-5 and cols. 13-14, lines 38+ and 1-23, respectively).

Claims 3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearson et al '259. Pearson discloses a game method using a number of information carrying cards containing all the elements of the claims including, compiling a number of

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information carrying cards having game (indicia 24) and control information (data in region 21), distributing collectable cards to players as required by claims 3 and 8 (col. 3, lines 35-50 and figure 2), players using the game information against each other to try to achieve victory over other players as required by claim 3 (col. 3, lines 35-50 and figure 2). The data in region 21 actuating the amusement device (12, 14 and 22 where it is considered that since video game images are displayed on a video screen (14) of a game system (12) there are parts that are actuated in response to reading the data (21)) and the amusement device being further actuable by an actuating key (read onto controllers 16 and 18) as required by claim 3. The amusement device acting according to and in association with information carried on one of the information carrying cards, as required by claims 6-7, is described in col. 3, lines 22-63. The information carrying cards being collectible, as required by claim 8, is taught in col. 2, lines 55-57.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathieu et al in view of Lebensfeld et al. Mathieu discloses an interactive amusement device containing most of the elements of the claims including, a body as

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required by claims 2 and 19 (fig. 1, element 22), at least two transport elements movably connected to a body as required by claim 2 and 21 (fig. 1, elements 38), at least two arms connected to a body as required by claim 2 (fig. 1), a motor associated with a body and coupled to two transport elements as required by claims 2 and 19 (fig. 6, elements 42) a microprocessor as required by claims 2 and 19 (figure 6, element 58), a wireless receiver associated with a body as required by claims 2 and 20 (fig. 8, element 64), a unit wireless transmitter associated with a body and coupled with a microprocessor as required by claims 2 and 20 (figure 1, element 20), a remote wireless transmitter operably coupled with a wireless receiver as required by claims 2 and 20 (figure 1, element 46).

Although Mathieu discloses most of the elements of the claims the reference fails to explicitly teach arms being movably connected to a body as required by claim 2, a key receiving device as required by claims 2 and 19, a device being able to transform into at least two different forms as required by claims 2 and 22-23. However, Lebensfeld discloses an interactive device, like that of Mathieu, which teaches arms movably connected to a body (col. 7, lines 31-36), a key receiving device (fig. 5, element 49 and col. 9, lines 35-39), a device being able to transform into at least two different forms (col. 10, lines 49-53) where it is considered that an addition of any accessory would be a different form of the device, a function of the amusement device being armor setting or weapons setting (col. 6, lines 28-37), a base having a peg and an engagement slot on a body having a mating shape (figure 5, elements 48 and 49). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed

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invention to manufacture the device of Mathieu with all of the above mentioned features of Lebensfeld for the purpose of providing a low cost upgradable/changeable interactive toy with multiple functions for added play value of the user.

Claims 9-16 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al in view of Mathieu et al. Lebensfeld discloses most of the elements of the claims including a body as required by claims 9 and 19 (fig. 4, element 10), at least two transport elements movably connected to a body as required by claims 9 and 21 (fig. 1, legs), a microprocessor as required by claims 9 and 19 (figure 6, element 60), a data card reader (a computer/disc drive) configured to read a data card (floppy disk) whereby a function of the device is modified since the device is made to receive upgrade data/functions as required by claims 9 and 24 (col. 9, lines 35-43) where a computer/disk drive is considered to be a data card reader since a computer clearly reads information from floppy disks/cards through a disk drive. Armor, as required by claim 11, is read onto elements 31 and 27 shown in figure 4. A weapon with microprocessor being configured to control at least one function of the weapon, as required by claim 12, is described in col. 8, lines 50-61. A keying device being a peg (48) with a mating shape configured to be received in an engagement slot with a matching mating shape (49), as required by claims 15-16 and 19, is shown in figure 5. Couplings, as required by claims 21 and 22, are inherent in the movable elements of Lebensfeld since without them the elements would not be able to move.

Although Lebensfeld et al discloses most of the elements of the claims the reference fails to teach a motor associated with a body and coupled to two transport elements as required by claims 10 and 20, a wireless receiver associated with a body as required by claims 9 and 20, a unit wireless transmitter associated with a body and coupled with a microprocessor as required by claims 9 and 20, a remote wireless transmitter operably coupled with a wireless receiver as required by claims 9 and 20. However, Mathieu discloses an interactive amusement device like that of Lebensfeld, which teaches a motor associated with a body and coupled to two transport elements (fig. 6, elements 42), a wireless receiver associated with a body (fig. 8, element 64), a unit wireless transmitter associated with a body and coupled with a microprocessor (figure 1, element 20 and figure 7, element 58), a remote wireless transmitter operably coupled with a wireless receiver (figure 1, element 46). Therefore it would have been obvious in view of Mathieu, to manufacture the device of Lebensfeld with the above mentioned features for the purpose of providing a remote controlled device that can simulate a "battle" scenario. Although Lebensfeld does not disclose a keying device being a flag it would have been obvious to make such a device a flag since Lebensfeld discloses a variety of play scenarios with using a variety of accessories (col. 10, lines 44-62). Furthermore the shape of the keying device would have been an obvious choice of design in that the applicant discloses no advantage or critical need for it (see applicant specification page 32, lines 19-21).

Response to Arguments

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Applicant's arguments filed 3 February 2003 have been fully considered but they are not persuasive. Applicants' argue that Pearson does not disclose information carrying cards and an actuating key. The examiner disagrees and directs the applicants attention to the above rejection, and further points out that the controllers (16 and 18) of Pearson are considered to be actuating keys as such controllers are well known to be plugged in the amusement device (12) to actuate system components by the users.

Regarding applicants arguments directed to Lebensfeld and a key receiving device, the examiner directs the applicants to the above rejection and points to figure 5 and col. 9, lines 35-39 of Lebensfeld and points out that a processor would have to be actuated for data transfer and use thereof.

Applicants' further argue that Lebensfeld teaches away from the combination with Mathieu. Examiner agrees that Lebensfeld speculates of the deficiencies of U.S. Patent 4,938,483 however the Mathieu reference is not Patent 4,938,483 and the generalities of the speculative deficiencies of patent 4,938,483 do not have to apply to the Mathieu reference. Furthermore, even though Lebensfeld discusses the deficiencies of 4,938,483, the device of Lebensfeld is similar in nature and use the same/similar components. For example, Lebensfeld clearly states that his inventions encompasses the use of a remote control device to control a variety of functions of the toy (col. 3, lines 18-25) as well as having movable parts which are actuated by a motor (col. 9, lines 49-54). Therefore not only is the combination of Lebensfeld and Mathieu appropriate but actually taught/implied by the Lebensfeld reference.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ds
April 21, 2003



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700